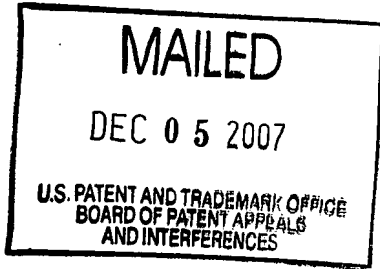


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ADAM R. SCHRAN and ROBERT E. DARLINGTON

Application 09/820,054

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on December 1, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing is identified below:

APPEAL BRIEF

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on January 31, 2007.

37 CFR § 41.37 (2006) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

...

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

...

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

...

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

...

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

The Appeal Brief filed January 31, 2007 is not compliant with the above because:

1. the separate headings appearing on pages 5, 10 and 12 in the “Argument” section do not match the grounds of rejection listed on page 5 under the heading “Grounds of Rejection to be Reviewed on Appeal”; and

2. a copy of the § 1.131 Declaration filed April 11, 2006¹ does not appear in the “Evidence Appendix.”

Correction is required.

EXAMINER’S ANSWER

In addition, in the Final Rejection mailed November 21, 2006, the following rejections were made:²

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,286,001 issued to Walker et al (hereafter Walker) and further in view of US Pat No 6,851,060 issued to Shrader (hereafter Shrader), as best examiner is able to ascertain [page 2];

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Walker and Shrader and further in view of Julien Jay [page 4]; and

Regarding claims 7-30, examiner maintains that these claims can be rejected o [sic] a similar basis as claims 1-6 [page 5].

However, in the Examiner’s Answer mailed June 7, 2007, the examiner lists the following rejections:

¹ The § 1.131 Declaration was considered pursuant to the Non-Final Rejection mailed May 15, 2007.

² According to the “Claims Status” appearing on page 2, “Claims 1-30 are pending” and “Claims 1-30 are rejected.”

Claims 1, 2 and 4-8, 10-17, 19-23 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,286,001 (Walker et al), hereafter Walker in view of US Pat No 6,851,060 (Shrader), hereafter Shrader [page 4];

Claims 3, 9, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Walker and Shrader as applied to claims 1, 7, 16 and 22 and further in view of Julien Jay [page 10].

In the Final rejection mailed November 21, 2006, the Examiner stated “Regarding claims 7-30, examiner maintains that these claims can be rejected on a similar basis claims 1-6”. However, no explanation of these possible rejections followed. It appears that the above two grounds of rejection are new grounds of rejection.

37 CFR § 41.39 (2006) states:

§ 41.39 Examiner’s answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner’s answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to

the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters

in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and
Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed June 7, 2007. Once the Examiner's Answer mailed June 7, 2007, the examiner has the following options:

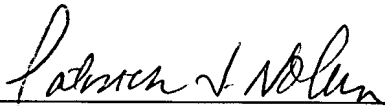
- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

Accordingly, it is

ORDERED that the application is returned to the examiner:

- 1) for submission of an amended Appeal Brief which corrects the “Argument” section and “Evidence Appendix”;
- 2) for consideration of the amended Appeal Brief;
- 3) to vacate the Examiner’s Answer mailed June 7, 2007;
- 4) to select one of the following options:
 - a) reopen prosecution;
 - b) write a new Examiner’s Answer without the new grounds of rejection; or
 - c) write a new Examiner’s Answer properly setting forth the new grounds of rejection; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
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Deputy Chief Appeals Administrator
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PJN:psb

Application 09/820,054

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